

**REMARKS**

In response to the Office Action of April 8, 2004, Applicant respectfully requests reconsideration. To further the prosecution of this application, each of the rejections set forth in the Office Action is addressed below. Claims 1-27 are currently pending in this application and claims 1, 16, and 22 are amended herein. The application is believed to be in condition for allowance.

Initially, the undersigned wishes to thank Examiner Anderson for taking the time to conduct a telephone interview on June 8, 2004. The substance of the interview is summarized herein.

**Request For Withdrawal Of Final Office Action Based on Improper Reliance On A Commonly Assigned Patent Under §103**

Claims 6, 8, and 10 are rejected under 35 U.S.C. §103(a) as purportedly being obvious over Fisher (6,247,096) and Blumenau (6,295,575). Applicant respectfully traverses this rejection.

During the telephone interview, the undersigned pointed out that Blumenau and the present application are commonly assigned to EMC Corporation. As Blumenau qualifies as prior art only under 35 U.S.C. §102(e), Blumenau cannot be used in a rejection under 35 U.S.C. §103.

Specifically, 35 U.S.C. §103(c) states, "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Accordingly, it is respectfully requested that the rejection of claims 6, 8, and 10 be withdrawn.

As discussed below, the other rejections are believed to have been overcome, such that the application is believed to be in condition for allowance. If the Examiner does not agree, he is requested to at least issue a new Office Action in view of the improper reliance on Blumenau.

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**Rejections Under 35 U.S.C. §102**

The Office Action rejected claims 1-5, 7, 9, and 11-27 under 35 U.S.C. §102(e) as purportedly being anticipated by Fisher (6,247,096). Applicant respectfully traverses this rejection.

**Claim 1**

Claim 1 is directed to a method of inventorying logical volumes in a computer storage system, the computer storage system comprising a plurality of storage elements coupled together with a communication network. The method comprises steps of: for each of a plurality of logical volumes, maintaining identifying information for each user of the respective logical volume, wherein the respective logical volume may have multiple users; and for each of the plurality of logical volumes, verifying that the logical volume is still in use.

Claim 1 patentably distinguishes over Fisher, as Fisher does not disclose or suggest, "for each of a plurality of logical volumes, maintaining identifying information for each user of the respective logical volume, wherein the respective logical volume may have multiple users."

The Office Action asserts that, "Fisher teaches in column 5, lines 1-7, that the tape management database includes information for each logical volume including expiration, *owner*, access, etc." (See Office Action, paragraph 27, page 7). As discussed during the telephone interview, Fisher does not teach or suggest an owner of a logical volume, but rather refers to an owner of a data set. In addition, Fisher does not teach or suggest that an owner of a data set is a user of a data set. In this respect, Fisher provides no explanation at all concerning what constitutes an owner of a data set.

As also discussed during the telephone interview, the owner of a data set may well differ from a user of the data set. For example, the owner of a data set may be an administrator or manager of the data set that does not use the data. The Examiner pointed out that if that were the case, the difference between an owner and user may be somewhat semantic. However, it was discussed that Fisher clearly teaches only a single owner for a data set, and does not make reference to multiple owners for a data set. Conversely, aspects of the present invention are capable of being employed with multiple users of a logical volume, and storing information relating to each of the users.

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In view of the foregoing, Applicant has amended claim 1 to clarify that "the respective logical volume may have multiple users." Fisher does not disclose or suggest this limitation, as Fisher discloses a database that identifies only a single owner for a data set. Thus, claim 1 patentably distinguishes over Fisher. Accordingly, it is respectfully requested that the rejection of claim 1 under 35 U.S.C. §102(e) be withdrawn.

Claims 2-15 depend from claim 1 and are patentable for at least the same reasons. Accordingly, it is respectfully requested that the rejection of claims 2-15 be withdrawn.

Claim 16

Claim 16 is directed to a storage element, comprising: a storage medium to store logical volumes; an access manager module configured to maintain identifying information for each user of the logical volumes stored on the storage medium, wherein the access manager module is configured to maintain identifying information for multiple users for each of the logical volumes; and a verifier module, coupled to the access manager module, to perform verification that a logical volume is still in use.

As should be clear from the discussion above, Fisher fails to disclose or suggest, "an access manager module configured to maintain identifying information for each user of the logical volumes stored on the storage medium, wherein the access manager module is configured to maintain identifying information for multiple users for each of the logical volumes," as recited in claim 16. Accordingly, it is respectfully requested that the rejection of claim 16 under 35 U.S.C. §102(e) be withdrawn.

Claims 17-21 depend from claim 16 and are patentable for at least the same reasons. Accordingly, it is respectfully requested that the rejections of claims 17-21 be withdrawn.

Claim 22

Claim 22 is directed to a storage management facility for a computer system that includes a plurality of storage elements and a plurality of host computers, comprising an access manager module configured to maintain identifying information for each user of the logical volumes stored on the storage medium, wherein the access manager module is configured to maintain identifying information for multiple users for each of the logical volumes; and a verifier module,

coupled to the access manager module, to perform verification that a logical volume is still in use.

As should be clear from the discussion above, Fisher fails to disclose or suggest, "an access manager module configured to maintain identifying information for each user of the logical volumes stored on the storage medium, wherein the access manager module is configured to maintain identifying information for multiple users for each of the logical volumes," as recited in claim 22. Accordingly, it is respectfully requested that the rejection of claim 22 under 35 U.S.C. §102(e) be withdrawn.

Claims 23-27 depend from claim 22 and are patentable for at least the same reasons. Accordingly, it is respectfully requested that the rejections of claims 23-27 be withdrawn.

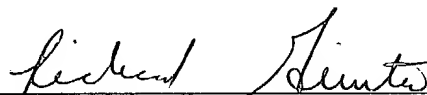
CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below to discuss any outstanding issues relating to the allowability of the application.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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